UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIKO OKAMOTO, TATSUNARI GOTO, and
JEAN-FRANCOIS NADAUD

Appeal 2006-2142
Application 09/667,420
Technology Center 1600

Decided: November 2, 2006

Before PAK, KRATZ, and TIMM, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-4, 6-10, and 18-40, the only claims pending in this application.[1] We have jurisdiction pursuant to 35 U.S.C. § 134.

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[1] An Oral Hearing took place on October 18, 2006.

The claimed invention is directed to a gel composition, cosmetic compositions employing such a gel composition, and a process for stabilizing such a composition. Claim 1 is illustrative of the claimed subject matter and reproduced below:

1. A gel composition comprising:

(1) at least one gelling agent comprising at least one polyacrylamide-based polymer, and

(2) at least one ingredient surface treated with at least one fluorine compound, wherein the at least one ingredient is chosen from pigments and fillers.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Takuta	JP 11-021227	Jan. 26, 1999
Cermasov	US 5,976,510	Nov. 2, 1999

Claims 1-4, 6-10, and 18-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of JP11-021227 and Cernasov.

OPINION

Upon review of the opposing arguments and evidence advanced by the Examiner in the Answer and Appellants in the briefs in support of their respective positions, we conclude that the Examiner has not established a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the Examiner's § 103 rejection for reasons set forth in Appellants' Briefs and as further discussed below.

Under 35 U.S.C. § 103(a), the Examiner must carry the initial burden of establishing a prima facie case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). As part of meeting this initial burden, the Examiner must determine whether the differences between the subject matter of the claims and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art" (emphasis added). 35 U.S.C. § 103(a)(1999); *Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). The applied prior art references as a whole must be viewed from the perspective of one of ordinary skill in the art to determine whether "some suggestion" is present to arrive at the claimed subject matter. *Cf. In re Mills*, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972).

The Examiner has found that JP 11-021227 discloses a gel composition including polyacrylamide that is useful as a cosmetic material. Moreover, the Examiner has determined that JP 11-021227 suggests that pigments and fillers may be employed in the cosmetic composition. However, the Examiner acknowledges that JP 11-021227 does not disclose the use of a pigment and/or filler that was surface treated with at least one fluorine compound as required by the appealed claims before us (Answer 2).

The Examiner turns to Cernasov for an alleged teaching of a cosmetic sunscreen and tanning composition that includes inorganic pigments treated with a perfluoroalkyl phosphate as a water and oil repellant.

At page 4 of the Answer, the Examiner takes the position that:

> Both Cernasov and the JP reference disclose [a] cosmetic composition and are thus in the same field of endeavor. Two compositions, "each of which is taught in the prior art to be

> useful for the same purpose" can be combined "to form a third composition to be used for the very same purpose," according MPEP 2144.06. "[Tlhe idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626, F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).
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> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the combined composition of Cernasov and the JP reference. One having ordinary skill in the art would have been motivated to do so with the expectation that the combined composition would be effective for the very same purpose as [a] cosmetic and the combined composition would have excellent water-repellant, oil-repellant characteristics.

As explained by Appellants, however, the Examiner's reliance on *In re Kerkoven* is misplaced. In this regard, Cernasov teaches that subsequent processing of cosmetic products including perflouroalkyl phosphate treated pigments "is not generally possible due to the water and oil-repellent characteristics" thereof (para. bridging cols. 1 and 2). Here, the Examiner has not proffered a persuasive rationale as to why one of ordinary skill in the art would disregard the admonitions set forth in Cernasov with respect to the specific requirements for obtaining a stable formulation in modifying the cosmetic composition of JP 11-021227. In particular, the Examiner has not articulated a particularized suggestion based on the applied references teachings and/or the level of skill in the art that would have led one of ordinary skill in the art to the proposed modification of JP 11-021227. In this regard, the proposed plucking of the surface treated pigment ingredient from the stable formulation described in Cernasov for use in combination with the different cosmetic gel composition of JP 11-021227 appears to

premised on impermissible hindsight. As explained by Appellants, Cernasov discloses that it is the particular inventive combination of cosmetic ingredients employed in the cosmetic composition thereof that results in the skin moisturizing properties of the stable cosmetic formulation of Cernasov, not the surface treated pigment per se (Br. 13 and Reply Br. 4).

Moreover, the Examiner has not advanced any persuasive basis that such a modification of JP 11-021227 would be attended by a reasonable expectation of success given the generalized discrediting information furnished by Cernasov that militates against such indiscriminate processing of flourine compound surface treated pigments with any cosmetic composition. In this regard, the Examiner has not fairly explained why one of ordinary skill in the art would have found the use of perfluoroalkyl phosphate treated pigments compatible with polyacrylamide-containing cosmetic compositions as described in JP 11-021227 based on the combined teachings of the applied references.

Because we determine that the Examiner has not furnished a prima facie case of obviousness based on the rationale furnished in the Answer, we need not reach the Declaration evidence furnished by Appellants in rebuttal.

CONCLUSION

The decision of the Examiner to reject claims 1-4, 6-10, and 18-41 under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of JP11-021227 and Cernasov is reversed.

REVERSED

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